

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

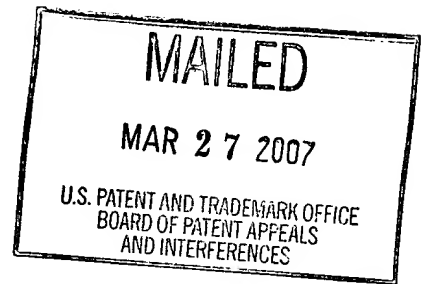
**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte

PAUL G. GLUCINA and MICHAEL T. MALONE

Appeal No. 2006-0355
Application No. 09/905,574
Technology Center 1600

ON BRIEF



Before SCHEINER, ADAMS, and GRIMES, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the final rejection of claim 1 under 35 U.S.C. § 112, first and second paragraphs. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

This appeal concerns a plant patent application directed to a variety of peach tree named 'GL4/66.' Specification 1. Claim 1, the sole claim, is as follows:

1. We claim a new and distinct variety of peach tree named 'GL4/66' substantially as illustrated and described.

The Examiner rejected claim 1 under the first and second paragraphs of 35 U.S.C. § 112.¹ According to the Examiner, claim 1 is not supported by “[a] disclosure of the plant which is ‘as full and complete . . . as possible’” (Answer 5), and “[d]escribing the plant by using term[s] such as ‘large’ and ‘medium,’ without further elaboration, is vague and ambiguous” (*id.* at 6).

PRINCIPLES OF LAW

35 U.S.C. § 162 (Rev. 2, May 2004) states in relevant part:

No plant patent shall be declared invalid for non-compliance with section 112 of this title if the description is as complete as reasonably possible.

37 CFR § 1.163(a) (July 2004) sets forth the manner in which a plant should be described in the specification of a plant patent application as follows:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

ISSUE ON APPEAL

The issue in this appeal, then, is whether the Examiner has established that Appellants’ description of the peach tree named ‘GL4/66’ is insufficient

¹ The Answer does not specifically identify the grounds of rejection, but the final rejection (mailed October 22, 2002) indicates that the claim is rejected under the first and second paragraphs of 35 U.S.C. § 112.

to satisfy the requirements of 35 U.S.C. § 162 and 37 CFR § 1.163(a), and therefore insufficient to satisfy the requirements of the first and second paragraphs of 35 U.S.C. § 112.

FINDINGS OF FACT

1. According to Appellants, ‘GL4/66’ “originated from an open pollinated population of seedlings derived from the variety ‘Yumyeong’ planted in 1990 at the HortResearch experimental orchard in Havelock North, New Zealand” (Specification 1: 6-8), and “one seedling representing the present variety was selected and asexually propagated for further evaluation . . . The selection was further propagated by asexual reproduction for the first time in 1995” (*id.* at 1: 9-12).
2. According to Appellants, the single photograph filed with the application “shows typical specimens of the foliage and the fruit of the new variety [‘GL4/66’] [] depicted in colours as nearly true as is reasonably possible . . . The upper and lower surfaces of the leaves, and [] exterior view[s] of the fruit, are shown. The photograph was taken after two weeks air storage of fruit harvested at eating maturity” (*id.* at 2: 5-9).
3. According to Appellants, ‘GL4/66’ produces “medium to large white flesh, clingstone fruit with a sweet sub-acid taste and very firm crisp flesh with good fruit aroma . . . The firm flesh exhibits good storage and the skin has an attractive pink colour over a cream background. The fruit ripens mid season approximately two weeks before the ‘Yumyeong’ parent variety.” *Id.* at 1: 21 to 2: 2.

4. A botanical “description of the new variety with colour terminology in accordance with the Royal Horticultural Society Colour Chart, 1986 edition” is provided on pages 2-6 of the specification. According to Appellants, “[t]he specimens described were grown in Havelock North and Clyde, Central Otago, New Zealand” and “[t]he observations were made in the 2001 season on trees which were four years old at the time” (*id.* at 2: 13-15).

5. Claim 1 stands rejected under 35 U.S.C. § 112, first and second paragraphs, for a number of reasons, listed as items A-R on pages 3-4 of the Answer. Most of the reasons concern Appellants’ use of the terms “medium,” “medium to large,” “plump,” etc.

6. The Examiner did not reject the claim to ‘GL4/66’ under 35 U.S.C. § 102 as anticipated by the parent variety ‘Yumyeong,’ or any other peach tree.

ANALYSIS

According to the Examiner, “complete and precise descriptions are needed to aid in examining future plant patent applications. The distinguishing feature of the claimed plant appears to be the color of the fruit. The less detail that is provided in describing the rest of the plant, the more difficult it will be to distinguish any future fruited sports of the ‘GL4/66’ variety” (Answer 6). “[T]he patenting of [a] first plant (with a vague description) would create an obstacle to the patenting of future varieties” (*id.* at 7), and “[s]ubsequent applicants . . . would find it difficult to distinguish their plant from the first . . . when faced with a rejection under 35 U.S.C. § 102(b)” (*id.*).

Nevertheless, Appellants' description of 'GL4/66' appears to have been sufficient for the examiner to compare 'GL4/66' to prior art peach trees, including the parent peach tree, 'Yumyeong,' and to determine that the 'GL4/66' is distinguishable therefrom.

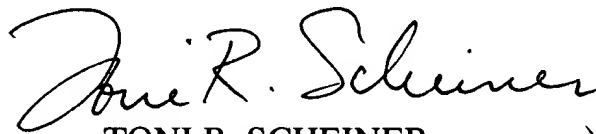
35 U.S.C. § 162 requires the description of a plant in a plant patent application to be as complete as "reasonably possible." 37 CFR § 1.163 is seemingly more restrictive than the statute in requiring "as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents," but it is plain that the purpose of the rule is to require that the description of the claimed plant must be sufficient to distinguish it from other varieties in the prior art. The Examiner has cited no authority, and we know of none, that supports the proposition that the description of a plant in a plant patent application must be sufficient to aid in examining purely hypothetical future plant patent applications.

The rejections of claim 1 under the first and second paragraphs of 35 U.S.C. § 112 are reversed.

CONCLUSION

The Examiner has not established that the present claim is indefinite, or lacks adequate written descriptive support. The rejections of claim 1 under the first and second paragraphs of 35 U.S.C. § 112 are reversed.

REVERSED



TONI R. SCHEINER
Administrative Patent Judge



DONALD E. ADAMS
Administrative Patent Judge



ERIC GRIMES
Administrative Patent Judge

)
)
)
) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
)
)

Appeal No. 2006-0355
Application No. 09/905,574

Michelle Bos
Stratton Ballew PLLC
213 South 12th Avenue
Yakima WA 98902